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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,557	10/14/2003	Charles S. Taylor	GUID-005CON6	5455
89729	7590	11/22/2011		
Law Office of Alan W. Cannon 1999 South Bascom Ave Suite 700 Campbell, CA 95008			EXAMINER SINGH, SUNIL K	
			ART UNIT 3732	PAPER NUMBER
			MAIL DATE 11/22/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/684,557	<b>Applicant(s)</b> TAYLOR ET AL.	
	<b>Examiner</b> SUNIL K. SINGH	<b>Art Unit</b> 3732	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 5) ☒ Claim(s) 1 and 224-234 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1 and 224-234 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                          |

### **DETAILED ACTION**

This application is in response to Applicant's amendments filed on 09/19/2011.

#### ***Priority***

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 08/603,758, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The prior filed application does not provide adequate support for the contact member that comprises a malleable member. Accordingly, claims 1,224-234 are not entitled to the benefits of the prior-filed application.

#### ***Claim Rejections - 35 USC § 102/103***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,224,226-228 and 230 are rejected under 35 U.S.C. 102(e) as anticipated by Boyd et al. (US 5,799,661) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Boyd et al. in view of Ley (US 5,514,076).

Boyd discloses a device that includes: a shaft (239) having a proximal end portion and a distal end portion (Figs. 42-44); a contact member (231) attached to the distal end portion of the shaft (Figs. 42-44); the contact member comprising a flexible main body (238) having a contact surface and an elongated malleable member extending along a length of said flexible main body member (metal wire) (column 21, lines 25-45); wherein the malleable member is **capable** of being shaped to engage the surface of the beating heart; wherein the malleable member is **capable** of being continuously adjustably shapeable by manipulation thereof to a desired shape and wherein upon release of manipulation forces, said malleable member maintains said desired shape and maintains a contact surface in the desired shape (column 19, lines 60-65 disclose that the wire is made of nickel/titanium alloy (also see column 21, lines 30-40) and such a material is malleable and capable of performing the intended function); wherein the shaft is **capable** of having sufficient strength to withstand a stabilizing force exerted on the heart via manipulation or fixation of said shaft to cause

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said contact member to exert a stabilizing force exerted on the heart via manipulation or fixation of said shaft to cause said contact member to exert a stabilizing force on the beating heart; wherein the contact member is substantially cylindrical (Fig. 44) and wherein the malleable member comprises a wire (column 21, lines 25-45). Boyd discloses the member being made of nickel/titanium alloy which is well known for its resiliency as well as for its shape memory characteristics. Ley is given as evidence that nitinol or nickel/titanium alloy are well known for their shape memory properties (column 4, lines 1-5). Therefore, it is the Examiner's position that Body does in fact disclose a malleable material.

However, in the alternative, if the Applicant believes that Boyd does not disclose a malleable material. Ley teaches a device that uses Nitinol in order to conform to the shape of the object. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Boyd to include a malleable material, as taught by Ley, in order to allow the contact surfaces to better conform to the heart and thus aids in stabilization.

4. Claims 225,229 and 231-234 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd/Ley and further in view of Buckman, Jr. et al. (US 5,582,580).

Boyd/Ley discloses the invention substantially as claimed except for a device that includes a vacuum for introducing positive/negative fluid pressure to the contact member.

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Buckman teaches a device that includes a means (vacuum)for introducing positive/negative fluid pressure to the contact member (82) and wherein the contact member (82) is malleable (Fig. 7) (column 9, line 28-column 10, line 63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Boyd/Ley to include a means for introducing pressure to the contact member, as taught by Buckman, in order to provide an alternate means of shaping the contact member that is allows the contact member to have a plurality of different shapes. Furthermore, such means are well known in the art.

### ***Response to Arguments***

5. The Arguments filed on 09/19/2011 are persuasive; however, are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUNIL K. SINGH whose telephone number is (571)272-3460. The examiner can normally be reached on Monday-Friday (Increased Flex Schedule).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris L. Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

11/19/2011

/SUNIL K SINGH/  
Primary Examiner, Art Unit 3732